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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/675,466

09/30/2003

Jeyhan Karaoguz

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EXAMINER

MENDOZA JR, JORGE

ART UNIT

PAPER NUMBER

4126

MAIL DATE

DELIVERY MODE

10/17/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/675,466

Applicant(s)

KARAOGUZ ET AL.

Examiner

Jorge Mendoza

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/24/2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09/30/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. **Claims 1-26** are presented for Examination.

Priority

2. A reference to the prior application No.60/478,552, filed on June 13, 2003, application No.60/432,472, filed on December 11, 2002, and application No. 60/443,894, filed on January 30, 2003 have been inserted as the first sentence(s) of the specification of this application or in an application data sheet (37 CFR 1.760. The claim for benefit of relying on the filing date of the prior application under 35 U.S.C. 119(e), 120, 121, or 365(c) is acknowledged.

Information Disclosure Statement

3. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered. Incorporated references (Attorney Docket No. 14825US01, Attorney Docket No. 14185US02, and Attorney Docket No. 14274US02) are disclosed in paragraph [0002] of the specification.

Specification

4. The disclosure is objected to because of the following informalities: *Information provided in paragraph [0002] is incomplete. US Patent Application numbers are missing in the Incorporated by Reference section. Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claims 1, 7-9, 15 and 16** are rejected under 35 U.S.C. 102(b) as being anticipated by **Sartain et al. (US Pat# 5,914,712)**.

Regarding **Claim 1**, the claimed "receiving, via a communication network, at least one notification of a user request for consumption of media, each of the at least one notification comprising information related to the request" is met by Sartain et al. that teaches a request by phone, set top box, or computer from a user to a cable provider, whereby the request includes a video selection number, subscriber identification, and/or credit card information (Fig.1; col.2, lines 60-64; col.3, lines 7-10, col.4, lines 51-55; col.4, lines 18-26, lines 36-43, and col.7, lines 14-20). The claimed "calculating at least one statistic, using the information related to the request; identifying media using the at least one statistic" is met by Sartain et al. that teaches the use of a queue in keeping a count of the number of selections a particular video obtains from subscribers and

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moving videos with more selections up in the queue (col.5, lines 44-64). The claimed "scheduling the identified media according to the at least one statistic, for consumption via the communication network" is met by Sartain et al. that teaches scheduling media for viewing on a given channel according to the number of requests that it receives (col.5, 63-67 and col.6, lines 1-2). The claimed "updating a user interface with the scheduled identified media" is met by Sartain et al. that teaches the updating of a scroll bar with the selection number of the video request in order to provide feedback to the subscriber (Fig.2, col.3, lines 23-28; and col.4, lines 31-33).

Regarding **Claim 7**, the claimed "wherein at least one of the calculating, identifying, scheduling, and updating is performed on a periodic basis" is met by Sartain et al. teaching that the selectable media is updated once a day to once a week (col. 8, lines 42-43).

Regarding **Claim 8**, the claimed "at least one statistic is a ranking of the relative frequency of consumption of media" is met by Sartain et al. that teaches the use of a statistic, namely the number of subscribers who have requested a specific video, in scheduling a group of videos in a media channel (col.5, lines 56-67 and col.6, lines 1-2).

Claim 9 is met in part as previously discussed with respect to claim 1. The claimed "communicating at least one of the identified media and the at least one statistic to a provider of the media, via the communication network" is met by Sartain et al. that teaches that subscriber requests are received at a central location 120 and then sent to office 100, that compiles all of the 'necessary/desirable video programs" to be sent to

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headends 110, 112, and 114 along with data related to the number of subscribers that have selected a particular video (col.5, lines 57-62 and col.6, lines 12-38).

Claim 15 is met as previously discussed with respect to claim 7.

Claim 16 is met as previously discussed with respect to claim 8.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 2-6, and 10-14** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Sartain et al. (US Pat# 5,914,712)** in view of **Lu (US Pat# 7,065,778)**.

Regarding **Claim 2**, Sartain et al. teaches a method of allowing individual subscribers to control the media programming being broadcast to a select group of subscribers. However, Sartain et al. does not teach the claimed "information comprised at least one of an Internet protocol (IP) address, at media access control (MAC) address, an electronic serial number (ESN), a title, a subject, a time period, a genre, an artist, a media channel type, a mode, a language, and a user identifier". In the same field of endeavor, the Lu reference teaches a method of requesting media that involves a request that can include the IP address of the requesting party (col.10, lines 10-15).

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to combine the teachings of Sartain et al. with those of Lu since

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both to them are inventions relating to a subscriber's request for media. A person with ordinary skill in the art would have been motivated to make such a modification to Sartain et al. in order to allow individual subscribers a greater amount of selectable media.

Regarding **Claim 3**, the claimed "wherein the communication network comprises at least one of a cable infrastructure, a satellite network infrastructure, a digital subscriber line (DSL) infrastructure, an Internet infrastructure, an intranet infrastructure, a wired infrastructure, and a wireless infrastructure" is met by Lu teaching a network in which the PVR's 200, 200A, 200B, and EPG server 304 of network 300 can be connected by coaxial cable, copper wire, fiber optics, the Internet 302, and wireless communications (Fig.3, and col.7, lines 1-8).

Regarding **Claim 4**, the claimed "wherein the communication network is the Internet" is met as previously discussed with respect to claim 3.

Regarding **Claim 5**, the claimed "wherein the media comprises at least one of audio, a still image, video, real time video, and data" is met by Lu teaching a network 300 that can operate with audio, video, graphics, information, data, software media content (col.7, lines 25-28).

Regarding **Claim 6**, the claimed "wherein consumption comprises at least one of playing audio, displaying a still image, displaying video, and displaying data" is met by Lu teaching a display device 212 coupled to PVR 200 for displaying video, graphics, and/or alphanumeric characters (Fig.3 & 4, and col.6, lines 21-28).

Claim 10 is met as previously discussed with respect to claim 2.

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Claim 11 is met as previously discussed with respect to claim 3.

Claim 12 is met as previously discussed with respect to claim 4.

Claim 13 is met as previously discussed with respect to claim 5.

Claim 14 is met as previously discussed with respect to claim 6.

9. **Claims 17-26** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Lu (US Pat# 7,065,778)** in view of **Sartain et al. (US Pat# 5,914,712)**.

Regarding **Claim 17**, the claimed "a television display; a storage for storing media, the storage having an associated network address; a user interface accessible via the television display, the user interface supporting the selection of media for consumption; set top box circuitry communicatively coupling the storage to a communication network to support consumption of the selected media" is met by Lu that teaches a television 212 displaying an electronic programming guide (EPG) used to request specific media and a personalized video recorder having an associated network address and a storage device 218 (Fig.2; col.5, lines 26-35; col.6, lines 17-28, and lines 39-45).

The claimed "server software that receives via the communication network, a notification comprising at least one of the associated network address and information related to the media selected for consumption, and responds by calculating at least one statistic" is met in part by Lu that teaches an EPG server 304 that receives a request from PVR 200, along with its network address, for a specific media program and determines whether or not PVR's 200A or 200B connected to it will receive specific

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media programming (Fig.3, col.9, lines 8-15 & lines 48-57; and col.10, lines 10-15).

However, Lu does not teach the claimed "responds by calculating at least one statistic".

In the same field of endeavor, Sartain et al. teaches a method of allowing individual subscribers to control the media programming being broadcast to a select group of subscribers. Specifically, Sartain et al. that teaches the use of a queue in keeping a count of the number of selections a particular video obtains from subscribers and moving videos with more selections up in the queue (col.5, lines 44-64).

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to combine the teachings of Lu with those of Sartain et al. since both to them are inventions relating to a subscriber's request for media. A person with ordinary skill in the art would have been motivated to make such a modification to Lu in order to permit subscriber's requests with higher demand to be placed in the cache server 402 and thereby yield a system with better efficiency.

Regarding **Claim 18**, Lu teaches the system of Claim 17 where the media may include audio, video, graphics, information, data, software and/or the like (col.7, lines 25-28).

Regarding **Claim 19**, Lu teaches the consumption of media by way of displaying video and/or graphics on a display device 212 (col.6, lines 23-28).

Regarding **Claim 20**, Lu teaches the use of an IP address for PVR 200 (col.10, lines 10-15).

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Regarding **Claim 21**, Lu teaches a communication network in which the components are coupled via cable, copper wire, fiber optics, the Internet 302, wireless communication or the like (Fig.3, and col.7, line 1-8).

Regarding **Claim 22**, Sartain et al. teaches the use of subscriber selection time, video program selection number, subscriber selection time, or a credit card number in requesting a media program (col.3, lines 51-54, and col. 4, lines 23-26).

Regarding **Claim 23**, the claimed "at least one statistic is a ranking of the relative frequency of consumption of media" is met by Sartain et al. that teaches the use of a statistic, namely the number of subscribers who have requested a specific video, in scheduling a group of videos in a media channel (col.5, lines 56-67 and col.6, lines 1-2).

Regarding **Claim 24**, Lu teaches an EPG server 304 that upon receiving a request from PVR 200, determines whether or not the requested media is available from PVR's 200A or 200B and if so, schedules it for recording (col.10, lines 15-25).

Regarding **Claim 25**, Lu an EPG server 304 that performs the scheduling of requested media upon a user's request and upon determining requested media is available at a connected PVR (col.9, lines 5-26).

Regarding **Claim 26**, Lu teaches the transmittal of the requested media to a 3rd party, namely PVR 200C (col.7, lines 47-58).

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Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Allegrezza et al. (US 2004/0103437) discloses a video on demand system in which the video servers are managed according to the demand for specific content that they receive in a given period of time.

Herz et al. (US Patent #5,351,075) discloses a method and a system for the control by subscribers of the programming of select video programs on a given channel, by writing or phoning in their choices.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jorge Mendoza Jr.** whose telephone number is (571) 270-5087. The examiner can normally be reached on Monday through Friday 7:30 am – 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Dennis Chow** can be reached at (571) 272-7767. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

L. Y. Leo
Principal Examiner

L. Y. Leo